

Appl. Ser. No. 09/715,295

Att. Docket No. 10746/22

Reply to Office Action of March 25, 2004

REMARKS

Claims 6 and 15 are canceled without prejudice, and therefore claims 1 to 5, 7 to 14, 16 and 17 are now pending

Applicants respectfully request reconsideration of the present application in view of this response.

As regards paragraph eleven (11) of the Office Action, Applicants thank the Examiner for indicating that claims 7, 8, 10, 12, 16 and 17 contain allowable subject matter. While the rejections of the base claims may not be agreed with, to facilitate matters, claim 7 has been rewritten to include the features of claim 6 (which has been canceled without prejudice), and claim 16 has been rewritten to include the features of claim 15 (which has been canceled without prejudice). Accordingly, it is respectfully requested that the objections be withdrawn.

As regards paragraph one (1) of the Office Action, claims 1 to 6, 9, 11 and 13 to 15 were rejected under 35 U.S.C. § 102(b) as anticipated by Yonezawa, U.S. Patent No. 5,475,825.

As regards the anticipation rejection of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

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As explained above, while the rejections of the base claims may not be agreed with, to facilitate matters, claim 7 has been rewritten to include the features of claim 6 (which has been canceled without prejudice), and claim 16 has been rewritten to include the features of claim 15 (which has been canceled without prejudice). Also, claims 9 and 11 now depend from allowable claim 7, rather than canceled claim 6.

The “Yonezawa” reference refers to a semiconductor device having combined fully associative memories. As referred to in the abstract, Fig.2 shows a first CAM (content addressable memory) cell array and a first RAM (random access memory) cell array which together make up one entry are arranged in such a way that they face each other across a control circuit, and a second CAM cell array and a second RAM cell array which together make up one entry are arranged in such a way that they face each other across the control circuit. At the time of a hit in the first CAM cell array, the control circuit enables readout of the first RAM cell array, while it, at the time of a hit of the second CAM cell array, enables readout of the second RAM cell array.

The Office Action did not assert which feature in the “Yonezawa” reference corresponds to which feature in the rejected independent claims. While it is not believed that “Yonezawa” identically discloses (or even suggests) each feature of the rejected independent claims, to facilitate matters, claims 1 and 13 now provide that “said first selection process and said second selection process are performed in parallel at least in part” in the rejected independent claims. The “Yonezawa” reference does not at least disclose that two processes are performed in parallel. Since the first selection process and the second selection process are not performed in parallel in the entirety (as in Figs. 5, 6 and 8 of the present application), the language “at least in part” is added in claims 1, 7, 13, and 16.

Accordingly, 1 and 13 are allowable, as are their respective dependent claims 2 to 5 and 14. Claims 9 and 11 now depend from allowable claim 7 (which includes the features of claim 6 which has been canceled without prejudice). Claim 15 has been canceled without prejudice since its features have been included in claim 16 as presented.

In summary, it is respectfully submitted that all of claims 1 to 5, 7 to 14, 16 and 17 of the present application are allowable at least for the foregoing reasons.

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CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 1 to 5, 7 to 14, 16 and 17 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

If the Examiner should have any questions or wish to discuss this matter, The Examiner is encouraged to contact the undersigned (Aaron C. Deditch, Reg. No. 33,865), who may be contacted at 212-908-6417.

Dated: _____

7/22/2004

Respectfully submitted,
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